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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,228	06/01/2001	Jean Brossard	402078	3769

27717 7590 09/03/2004

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EXAMINER	
MOSSER, ROBERT E	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/872,228	BROSSARD, JEAN	
	Examiner	Art Unit	
	Robert Mosser	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,9-16,19-27,32-55,58 and 63-76* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,9-16,19-27,32-55,58 and 63-76* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9,10,13*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

♦

This non-final action is in response to the RCE entered April 27th, 2004.

Claims 1-4, 9-16, 19-27, 32-55, 58, 63-76 are pending.

♦

The official notices directed to the features of a moving member which stops randomly on a clip (*claims 64, 67, 70*), known use of bonus awards (*claims 11, 34, 36, 52*), the highlighting of indicia by illumination in slot machines (*claims 12-14, 41-43, 46*), and the use of mechanical slot machines (*claim 20*), as presented in the rejection of august 27th, 2003 were not refuted by the applicant and are now considered admitted prior art.

♦

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 27th, 2004 has been entered.

Information Disclosure Statement

IDS papers 9 and 10, are noted to be the same document and only one 1449 was submitted. Paper 10 has been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-4, 10, 19, 23, 32, 33, 37-40, 49-51, 53, 65, 68, 71, 74,** and **76** are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (US 6,234,896).

Walker teaches all of the claim limitations as presently presented and addressed in the office actions dated 8-27-03 and 1-28-04 incorporated herein by reference. The newly amended subject matter directed to a "no reward output" for which there is no monetary prize amount or audio visual display in responses to an outcome of said third outcome type as now included in claims **1, 32,** and **49**, is provide for by Walker in column 5, lines three through six. Specifically Walker teaches an alternative embodiment wherein there is not a "win" on every play. This correlates to the no reward output as so claimed and set forth above.

Regarding at least claims **3, 4** and **37-39**, Walker teaches he presentation of an audiovisual display including a celebrity themed video clip and audio portions (music video, movie Col 3:50) which are presented with response to a winning outcome of the second type and may be in combination with a payout (Col 5:3-6). Wherein the "music video" or "movie" of Walker is understood to contain either music celebrities or movie stars implicitly.

Regarding at least claims **10, 40, 51, 65 68, 71,** and **76** Walker teaches the presentation of video clips (songs) of a player preferred category (Col 4:12-29) and an input device (28). As the player must in some way inherently indicate this preferred category to the gaming device in order for the gaming device to be aware of this information. The examiner has interpreted this required process to read on permitting a player to select from a plurality of video (song) clips as so claimed in view of the above and the various categories shown in figure 4 of Walker.

Regarding at least claims **33** and **50**, Walker teaches the presentation of a audiovisual means (20) separate and distinct from a game outcome display means (Reels, Fig 2)

Regarding claim **53**, Walker teaches the transmission of the video from a central server for display or alternatively the storage of the video presentation on the local game machine (Col 3:17-37). The examiner has interpreted the server method to encompass the displaying of the motion picture by a second computer.

Regarding claim **74**, Walker teaches the use of his invention with a slot machine and the capability of awarding a monetary prize. The claimed aspect of

indicating the amount of a monetary prize awarded to a player in response to a winning outcome is held to be an inherent feature of a slot machine wherein the awarding of a prize resultant of a player win must indicate the amount of the prize (ie the player receives 25 credits on a win).

Regarding claims **2, 19,** and **23**, theses claims have been previously addressed in office actions cited at the beginning of this reject and will not be repeated herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim Rejections - 35 USC § 103

Claims **9, 15, 44, 63, 66, 69, 72-73,** and **75** are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,234,896).

Regarding claims **9, 15, 44, 63, 66, 69,** and **75,** Walker is silent regarding an explicit teaching of randomly selecting a video clip from a plurality of video clips in a chance machine. Walker however does teach a chance machine that displays video clips as laid forth above dependent on a random outcome (game outcome). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the game of Walker to display a random clip selected from a plurality of clips in order to lengthen the effective display time of a clip through the repeated display of portions of said clip.

Regarding claims **72** and **73**, walker is silent regarding the volatility of the gaming device, however while the implicit functionality of a chance gaming device is to award prizes to players while ensuring that the net monies entered into the game are higher then the net monies being distributed by the game the decision to award these monies in a few larger prizes or a plethora of small amounts is deemed to be a matter of design choices.

Claims **11-14, 16, 20, 34-36, 41-43, 45, 46, 52, 64, 67, and 70** are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,234,896) in view of applicant admitted prior art.

With regards to claim **11, 34-36, and 52,** Walker is silent regarding the means for generating a bonus award associated with the player selected video clip however, in view of the admitted prior art the inclusion of bonus awards with slot machine gaming is well known. It would have been obvious to one of ordinary skill in the art at the time of invention to have included a bonus prize

associated with the player selected video clip in order to further encourage a player to continue to wager at a gaming machine.

With regards to claims **12-14, 41-43, and 46,** Walker teaches the use of a plurality of video clips (Fig 4-6) however is silent regarding the means for displaying indicia of a plurality of video clips and highlighting in said means for displaying indicia, said video clip selected from among a plurality of video clips however, in view of the admitted prior art the inclusion of the above described indicia and highlighting means through different levels of illumination in slot machine gaming is well known. It would have been obvious to one of ordinary skill in the art at the time of invention to have included means for displaying indicia of a plurality of video clips and highlighting through different levels of illumination in said means for displaying indicia, said video clip selected from among a plurality of video clips in the invention of Walker in order to indicate to a player visually the selected clip that they have chosen.

With regards to claim **16 and 45,** Walker is silent regarding permitting a game operator to select the available video clips from a larger set of video clips to be displayed on a gaming device. Walker does however teach the inclusion of a video database (44) for corresponding video ID numbers to their respective category (Fig 6). It would have been obvious to one of ordinary skill in the art at the time of invention to allow operator selection of available videos from a plurality of videos in through the modification of database (44) in the system of Walker in order to allow the updating of video media in the system.

With regards to claim **20,** Walker is silent regarding the inclusion of mechanical slot machine wheels however, in view of the admitted prior art the inclusion mechanical slot machine wheels with slot machine gaming is well known. It would have been obvious to one of ordinary skill in the art at the time of invention to utilize mechanical slot machine wheels in the invention of Walker in order to reduce display fabrication costs.

With regards to claims **64, 67, 70,** Walker is silent regarding the selection through a moving member of one video clip from a plurality of video clips in an array however in view of the admitted prior art the inclusion a such and arrangement with related device is well known. It would have been obvious to one of ordinary skill in the art at the time of invention to utilize the selection through a moving member of one video clip from a plurality of video clips in an array in the invention of Walker in order to increase player excitement and/or anticipation by lengthening the video clip selection process..

Claim **19** is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,234,896) in view of official notice.

Walker teaches the use of slot machine but is silent regarding the use of pay lines. The examiner gives official notice that the inclusion of pay lines into a slot machine is old and well known in the field of chance gaming devices.

Claims **21-22, 24-27, 47-48, 54-55** and **58** are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,234,896) in view of Acres et al (US 5,752,882).

The previous rejection of the claims **21-22, 24-27, and 47-48** (page 7 of the non-final office action mailed 8-27-2004) is maintained and incorporated by reference herein.

Regarding claims **54-55**, and **58**, the incorporation of pari-mutuel gaming has been previously addressed in at least the rejections of **21-22, 24-27**, and **47-48** previously under Walker/Acres and will not be repeated herein. Additional aspects directed to allowing a player to selected a media from a predefined set of media for display has been addressed in the rejection of claim ten under USC 102 and hence is considered included the combination of Walker/Acres. Features directed to distinct controllable displays and separate cabinet sections are also considered treated by Walker as presented above in the rejection of at least claim 33 under 102 and also is considered included in the combination of Walker/Acres.

Response to Arguments

Applicant's arguments filed 4-27-2004 have been fully considered but they are not persuasive.

Arguments directed to the incorporation of a no win outcome as now claimed .has been addressed in the amended rejection under the previously applied Walker reference.

Arguments directed to the random selection of a video clip to be displayed in a chance devise are non-persuasive. As the chance devices (slot machines) randomly determine the existence of a conventional payout and conventional payout amount during operation (ie If a spin yields a winning combination of symbols on the reels and payout associated with the combination of symbols), previous gaming machines have set forth the random determination of a prize. Walker teaches the use of video clips as a prize and the obvious type rejection posed merely equates the previously well known handling of conventional prizes to that of the video clip prize.

Arguments directed to the player or "operator" selection of a video clip are treated in the rejection above and will as such not be addressed here.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

JESSICA HARRISON
PRIMARY EXAMINER